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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEALTH HERO NETWORK, INC. 2000 SEAPORT BLVD. SUITE 400 REDWOOD CITY, CA 94063			MORGAN, ROBERT W	
			ART UNIT	PAPER NUMBER
			3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/237,194	Applicant(s) BROWN, STEPHEN JAMES	
	Examiner Robert W. Morgan	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004 and 18 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-138 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-138 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/18/04 has been entered.

Election/Restrictions

2. The examiner has withdrawn the restriction filed 5/19/05.

Notice to Applicant

3. In the amendment filed 11/4/05, following has occurred: claims 34, 71, 76, 77, 119-122 have been amended and claims 123-138 have been added. Now claims 34-138 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 34-41, 45-50, 52, 54-59, 61-63, 65, 66, 69-75, 77-84, 88-93, 95, 97-102, 104-106, 108, 109 and 112-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,803,625 to Fu et al. and U.S. Patent No. 4,838,275 to Lee in view of U.S. Patent No. 5,390,238 to Kirk et al.

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As to Claims 34-41, 45, 49, 50, 54-56, 59, 62, 63, 65, 66, 69-75, Fu discloses a networked health-monitoring system (see Fig. 1), comprising:

a plurality of remote patient sites (see Fig. 1, unit 60), each site including at least one display (i.e. unit 68)(col. 5, lines 53-58);

a data management unit configured to facilitate collection of patient health related data (i.e.. event table and CPU 64)(col. 10, lines 1-14 and lines 28-61);

a memory (i.e. unit 80)(see Fig. 2); and

stored program instructions for use in generating health-monitoring related information on the display (i.e. display unit 68 and software of the home unit) (col. 5, lines 56-57, col. 8, line 17 and col. 12, lines 1-24)

at least one central server connectable for communication with the data management unit at the patient sites (see Fig. 1).

Fu does not explicitly disclose

at least one remotely located computer facility including the at least one central server; and

at least one health care professional computer remotely located from and configured for signal communication with the central server, wherein the central server can generate a report based on the patient health-related data collected at the remote patient site and the report can be viewed at the at least one healthcare professional computer and wherein at least one message can be sent from the healthcare professional computer to the remote patient sites through the central server.

Lee discloses at least one health care professional computer remotely located from and configured for signal communication with the central server to receive at least one report based on the patient health-related data collected at the remote patient sites (i.e. unit 118a) (see Fig. 1, col. 11, lines 54-56 and col. 13, lines 42-47).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include at least one health care professional computer remotely located from and configured for signal communication with the central server to receive at least one report based on the patient health-related data collected at the remote patient sites as disclosed by Lee within Fu for the motivation of providing detailed home medical surveillance of patients with a minimal amount of trained technical personnel and minimal training and participation by the patient (Lee: col. 5, lines 15-38).

Fu and Lee do not explicitly disclose a remotely located computer facility including the at least one central server, wherein the central server can generate a report based on the patient health-related data collected at the remote patient site and the report can be viewed at the at least one healthcare professional computer and wherein at least one message can be sent from the healthcare professional computer to the remote patient sites through the central server.

Kirk teaches a health support system including a remotely located computer facility including the at least one central server wherein hardware and software of the central server automatically communicates with the data management units and at least one health care professional computer (col. 3, lines 3-11, lines 20-42). In addition, Kirk teaches that the central server can report results of the analysis of patient (32, Fig. 3) status to a doctor (24, Fig. 2), care provider (20, Fig. 2) or local monitoring services (12, Fig. 1) (see: column 5, lines 40-47).

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Furthermore, Kirk teach that the health support unit (30, Fig. 3) interacts with the local central server (38, Fig. 3) receive medication and program schedule updates (see: column 5, lines 22-27 and column 3, lines 3-11). The Examiner considers the medication and program schedule updates (messages) to be sent by the doctor or pharmacist computer to the local server and then to the patient.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation for the motivation of utilizing a health care support system which economically provides medication control, wellness checking and patient data accumulation and reporting capability (Kirk: col. 1, lines 53-60).

As to Claim 46, Fu does not explicitly disclose The system of claim 34, wherein the report is standardized.

However, Lee discloses wherein the report is standardized (col. 17, lines 20-40). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the report is standardized as disclosed by Lee within Fu for the motivation of providing detailed home medical surveillance of patients with a minimal amount of trained technical personnel and minimal training and participation by the patient (col. 5, lines 15-38).

As to Claim 47, Fu does not explicitly disclose the system of claim 34, wherein the system is configured to allow a health care professional to select which of a plurality of standardized reports is received.

However, Lee discloses wherein the system is configured to allow a health care professional to select which of a plurality of standardized reports is received (col. 13, lines 5-15). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention

to include the system is configured to allow a health care professional to select which of a plurality of standardized reports is received as disclosed by Lee within Fu for the motivation of providing detailed home medical surveillance of patients with a minimal amount of trained technical personnel and minimal training and participation by the patient (col. 5, lines 15-38).

As to Claim 48, Fu does not explicitly disclose the system of claim 34, wherein the report includes graphs and/or icons.

However, Lee discloses wherein the report includes graphs and/or icons (col. 13, lines 5-16). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the report includes graphs and/or icons as disclosed by Lee within Fu for the motivation of providing detailed home medical surveillance of patients with a minimal amount of trained technical personnel and minimal training and participation by the patient (col. 5, lines 15-38).

As to Claim 52, Fu does not explicitly disclose the system of claim 34, wherein the report includes displayed formatted statistical information.

However, Lee discloses wherein the report includes displayed formatted statistical information (col. 13, lines 12-17). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the report includes displayed formatted statistical information as disclosed by Lee within Fu for the motivation of providing detailed home medical surveillance of patients with a minimal amount of trained technical personnel and minimal training and participation by the patient (col. 5, lines 15-38).

As to Claim 57, Fu does not explicitly disclose the system of claim 55, wherein the message includes results of a test.

However, Lee discloses wherein the message includes results of a test (i.e. if there are no untoward signs, this is communicated to the patient)(col. 16, lines 39-43). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the message includes results of a test as disclosed by Lee within Fu for the motivation of providing detailed home medical surveillance of patients with a minimal amount of trained technical personnel and minimal training and participation by the patient (col. 5, lines 15-38).

As to Claim 58, Fu does not explicitly disclose the system of claim 55, wherein the message includes a diagnostic indication related to whether a test has proceeded in a normal fashion.

However, Lee discloses wherein the message includes a diagnostic indication related to whether a test has proceeded in a normal fashion (i.e. if there are no untoward signs, this is communicated to the patient)(col. 16, lines 39-43). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the message includes a diagnostic indication related to whether a test has proceeded in a normal fashion as disclosed by Lee within Fu for the motivation of providing detailed home medical surveillance of patients with a minimal amount of trained technical personnel and minimal training and participation by the patient (col. 5, lines 15-38).

As to Claim 61, Fu does not explicitly disclose the system of claim 55, wherein the message is from the health care professional computer.

However, Lee discloses wherein the message is from the health care professional computer (col. 16, lines 40-43).). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the message includes a diagnostic indication

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related to whether a test has proceeded in a normal fashion as disclosed by Lee within Fu for the motivation of providing detailed home medical surveillance of patients with a minimal amount of trained technical personnel and minimal training and participation by the patient (col. 5, lines 15-38).

As to claims 77-84, 88-93, 95, 97-102, 104-106, 108, 109 and 112-118, the claims are similar in scope to claims 34-41, 45-50, 52, 54-59, 61-63, 65, 66, 69-75 and are rejected on the same basis.

5. Claim 42, 44, 85 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu, Lee, and Kirk as applied to claims 34 and 77 above, and further in view of Beckers, Pat. No. 5,019,974.

As to Claim 42, Fu and Lee do not explicitly disclose the system of claim 41, wherein the handheld device is capable of displaying pictorial health-monitoring related information.

However, Beckers discloses wherein the handheld device is capable of displaying pictorial health-monitoring related information (see Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the handheld device is capable of displaying pictorial health-monitoring related information as disclosed by Beckers within Fu, Lee, and Kirk for the motivation of providing a patient with an individually tailored program of treatment (col. 1, lines 7-14)

As to Claim 44, Fu and Lee do not explicitly disclose The system of claim 42, wherein the handheld device is capable of displaying animated health-monitoring related information.

However, Beckers discloses wherein the handheld device is capable of displaying animated health-monitoring related information (see Fig. 2). It would have been obvious to one

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of ordinary skill in the art at the time of Applicant's invention to include wherein the handheld device is capable of displaying animated health-monitoring related information as disclosed by Beckers within Fu, Lee and Kirk for the motivation of providing a patient with an individually tailored program of treatment (col. 1, lines 7-14).

As to claims 85 and 87, the claims are similar in scope to claims 42 and 44 and are rejected on the same basis.

6. Claims 51, 53, 60, 64, 67 94, 96, 103, 107, 110, and 111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu, Lee, and Kirk as applied to claims 34 and 77 above, and further in view of Fujimoto, Pat. No. 5,339,821.

As to Claims 51, 53, 60, 64, 67, and 68, Fu, Lee, and Kirk do not explicitly disclose The system of claim 34, wherein the system is configured to cause the presentation of at least one report on the display at a remote patient site.

However, Fujimoto discloses wherein the system is configured to cause the presentation of at least one report on the display at a remote patient (col. 4, lines 48-56). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the system is configured to cause the presentation of at least one report on the display at a remote patient site as disclosed by Fujimoto within Fu and Lee for the motivation of providing a medical system and apparatus which permits patients to check or measure the condition of a disease at home (col. 1, line 66 – col. 2, line 5).

As to claims 94, 96, 103, 107, 110, and 111, the claims are similar in scope to claims 51, 53, 60, 67, and 68 and are rejected on the same basis.

7. Claims 43 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu, Lee, and Kirk as applied to claims 34 and 77 above, and further in view of Examiner's use of Official Notice.

As to Claim 43, Fu, Lee, and Kirk do not explicitly disclose the system of claim 40, wherein the memory is a program cartridge.

However, the Examiner takes official notice that it was well known in the computer arts to use program cartridges to program handheld devices. The motivation was to provide a simple and inexpensive means for providing computer programs that are popular or in demand by a number of users. . It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the memory is a program cartridge for the motivation stated above.

As to claims 86, the claim is similar in scope to claim 43 and is rejected on the same basis.

8. Claims 76 and 119-138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu, Lee and Kirk as applied to claims 40 above, and further in view of Examiner's use of Official Notice.

As to Claim 76, Fu, Lee, and Kirk do not explicitly disclose the system of claim 34, wherein the healthcare professional computer receives the report after transmitting an authorization code to the server that identifies an associated healthcare professional as an authorized user.

However, the Examiner takes official notice that it was well known in the computer arts to use personal identification numbers (pin) to authorize users to access systems, programs and

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stored data on computers. The motivation for using pin numbers was to grant access to data or the computer system to authorized users only, particularly sensitive data or information such as patient medical data. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the healthcare professional computer receives the report after transmitting an authorization code to the server that identifies an associated healthcare professional as an authorized user within Fu, Lee and Kirk for the motivation stated above.

As per claim 119, Fu discloses a networked health-monitoring system (see Fig. 1), comprising:

a plurality of remote patient sites (see Fig. 1, unit 60),

using stored program instructions to generate health-monitoring related information on at least one display (i.e. unit 68)(col. 5, lines 53-58);

facilitating collection of patient health-related data using a data management unit (i.e. event table and CPU 64)(col. 10, lines 1-14 and lines 28-61); and

stored program instructions for use in generating health-monitoring related information on the display (i.e. display unit 68 and software of the home unit) (col. 5, lines 56-57, col. 8, line 17 and col. 12, lines 1-24);

at least one central server connectable for communication with the data management unit at the patient sites (see Fig. 1).

Fu does not explicitly disclose

at least one remotely located computer facility including the at least one central server;
and

providing at least one report to at least one health care professional computer, remotely located from and in signal communication with the central server, the report being based on the patient health-related data collected at the remote patient sites,

wherein hardware and software of the central server allows at least one message sent from the health care professional computer to be sent remote patient site, and

receiving the report after transmitting an authorization code to the server that identifies an associated healthcare professional as an authorized user.

Lee discloses at least one health care professional computer remotely located from and configured for signal communication with the central server to receive at least one report based on the patient health-related data collected at the remote patient sites (i.e. unit 118a) (see Fig. 1, col. 11, lines 54-56 and col. 13, lines 42-47).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include at least one health care professional computer remotely located from and configured for signal communication with the central server to receive at least one report based on the patient health-related data collected at the remote patient sites as disclosed by Lee within Fu for the motivation of providing detailed home medical surveillance of patients with a minimal amount of trained technical personnel and minimal training and participation by the patient (Lee: col. 5, lines 15-38).

Fu and Lee do not explicitly disclose a remotely located computer facility including the at least one central server, wherein the central server can generate a report based on the patient health-related data collected at the remote patient site and the report can be viewed at the at least

one healthcare professional computer and wherein at least one message can be sent from the healthcare professional computer to the remote patient sites through the central server.

Kirk teaches a health support system including a remotely located computer facility including the at least one central server wherein hardware and software of the central server automatically communicates with the data management units and at least one health care professional computer (col. 3, lines 3-11, lines 20-42). In addition, Kirk teaches that the central server can report results of the analysis of patient (32, Fig. 3) status to a doctor (24, Fig. 2), care provider (20, Fig. 2) or local monitoring services (12, Fig. 1) (see: column 5, lines 40-47). Furthermore, Kirk teach that the health support unit (30, Fig. 3) interacts with the local central server (38, Fig. 3) receive medication and program schedule updates (see: column 5, lines 22-27 and column 3, lines 3-11). The Examiner considers the medication and program schedule updates (messages) to be sent by the doctor or pharmacist computer to the local server and then to the patient.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation for the motivation of utilizing a health care support system which economically provides medication control, wellness checking and patient data accumulation and reporting capability (col. 1, lines 53-60).

Fu, Lee, and Kirk do not explicitly disclose the system of claim 34, wherein the healthcare professional computer receives the report after transmitting an authorization code to the server that identifies an associated healthcare professional as an authorized user.

However, the Examiner takes official notice that it was well known in the computer arts to use personal identification numbers (pin) to authorize users to access systems, programs and

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stored data on computers. The motivation for using pin numbers was to grant access to data or the computer system to authorized users only, particularly sensitive data or information such as patient medical data. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the healthcare professional computer receives the report after transmitting an authorization code to the server that identifies an associated healthcare professional as an authorized user within Fu, Lee and Kirk for the motivation stated above.

As to claims 120-124, the claim are similar in scope to claim 119 and are rejected on the same basis.

As to claims 125-131, the claims are similar in scope to claims 57 and 72 and are rejected on the same basis.

As to claims 132-138, the claims are similar in scope to claims 119-124 and are rejected on the same basis.

Response to Arguments

Applicant's arguments filed 7/6/04 and 11/18/04 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses dated 7/6/04 and 11/18/04.

(A) In the remarks, Applicants argue in substance that, (1) the Examiner's rejections fails to establish a *prima facie* case of obviousness using three basic criteria (a) there must be some suggestion or motivation to combine or modify the references, (b) there must be a reasonable expectation of success, and (c) the prior art must teach or suggest each and every limitation of the claimed invention; (2) It is improper to combine references that change principles of

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operation, teach away from the combining or render unsatisfactory the combination; (3) the Examiner has not shown any specific teachings in the references for numerous dependent claims; and (4) Consideration of the Rule 131 Affidavit previously submitted.

(B) In response to Applicants arguments that (1) the Examiner's rejections fails to establish a *prima facie* case of obviousness using three basic criteria (a) there must be some suggestion or motivation to combine or modify the references, (b) there must be a reasonable expectation of success, and (c) the prior art must teach or suggest each and every limitation of the claimed invention and (2) the teachings to combine references must come from the references themselves. The Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see above).

As such, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the

references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lahu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Further, according to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

As such, it is respectfully submitted that an explanation based on logic and sound

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scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the above-mentioned Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

In addition, the primary motivation for combining the respective teachings of Lee and Fu was clearly recited "...providing detailed home medical surveillance of patients with a minimal amount of trained technical personnel and minimal training and participation by the patient (see above last lines of first paragraph of page 3). Furthermore, the primary motivation to combine the teachings of Kirk with the teachings of Fu and Lee are clearly recited "...utilizing a health care support system which economically provides medication control, wellness checking and patient data accumulation and reporting capability (see above page 4, second paragraph last lines). Not only was this motivation explicitly recited in the rejection of the claims, it was based solely on the teachings of the prior art, namely, column 5, lines 15-38 of Lee et al. and column 1, lines 53-60 of Kirk. As such, the Examiner respectfully contends that the first requirement needed to establish a *prima facie* case of obviousness, namely, a showing of a suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, has been clearly established in the rejection applied in this case.

(B) In response to Applicants arguments that (2) It is improper to combine references that change principles of operation, teach away from the combining or render unsatisfactory the combination. The Examiner respectfully submits that there is no evidence that the applied references teach away from applicant invention. In addition, the Fu reference is relied on for teaching a plurality of remote patient sites (see Fig. 1, unit 60), each site including at least one

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display (i.e. unit 68) (col. 5, lines 53-58). In addition, Fu teaches a data management unit configured to facilitate collection of patient health related data (i.e., event table and CPU 64) including memory using stored program instructions for use in generating health-monitoring related information on the display (i.e. display unit 68 and software of the home unit) with at least one central server connectable for communication with the data management unit at the patient sites (col. 10, lines 1-14 and lines 28-61, col. 5, lines 56-57, col. 8, line 17 and col. 12, lines 1-24). Lee is relied on for teachings at least one health care professional computer remotely located from and configured for signal communication with the central server to receive at least one report based on the patient health-related data collected at the remote patient sites (i.e. unit 118a) (see Fig. 1, col. 11, lines 54-56 and col. 13, lines 42-47). Kirk is relied on for teaching a health support system including a remotely located computer facility including the at least one central server wherein hardware and software of the central server automatically communicates with the data management units and at least one health care professional computer (col. 3, lines 3-11, lines 20-42). In addition, Kirk teaches that the central server can report results of the analysis of patient (32, Fig. 3) status to a doctor (24, Fig. 2), care provider (20, Fig. 2) or local monitoring services (12, Fig. 1) (see: column 5, lines 40-47). Furthermore, it is respectfully submitted that if Applicant's were correct in his assertion which Examiner does not admit, it has been held that prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

(C) In response to Applicants arguments that (3) the Examiner has not shown any specific teachings in the references for numerous dependent claims. The Examiner respectfully submits

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that dependent claims 77-84, 88-93, 95, 97-102, 104-106, 108, 109 and 112-118 recite similar subject matter which has been address in the rejection of 34-41, 45-50, 52, 54-59, 61-63, 65, 66, 69-75. Therefore, Examiner would direct Applicant's attention to previously rejected claims with parallel subject matter.

(D) In response to Applicants arguments that (4) Consideration of the Rule 131 Affidavit previously submitted. The Examiner respectfully submits at page 8 of the 11/18/04 response, Applicant directs the Examiner to a Declaration/Affidavit filed under 37 C.F.R § 1.131 along with evidence demonstrating Applicant arrived at his invention prior to filing date of the Kirk invention. The Examiner respectfully submits that the documents submitted by the Applicant indicate that conception of the invention took place around March 2, 1992. However, Applicant has failed to provide specific evidence that he worked diligently from March 2, 1992 until an actual reduction to practice date, or that he worked diligently from prior to June 15, 1992 (constructive reduction to practice for the Kirk reference) until November 17, 1992.

MPEP § 2138.06 states the following:

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964)(statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (*Diligence requires that applicants must be specific as to dates and facts.*) (*Emphasis added*)

The declaration includes copies of faxed letters from Applicant's to his attorney, thereby alleging diligence in reduction to practice of the instant invention. The Applicant also provides a copy of a check and drawings however, the evidence submitted by the Applicant does not account for any of the time lapses indicated by the date of the faxed letters and drawings to the date of the Kirk reference (filed 6/15/92). As such, it is submitted that the Applicant has failed to provide evidence to fully account for the time period during which due diligence must be established.

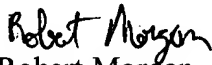
Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (571) 272-6773. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Art Unit 3626


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